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IN THE

Supreme Court of the United States

OCTOBER TERM, 1965

No. 337

R. A. HANSON AND R. A. HANSON CO., INC., *Petitioners*,

v.

NO-JOINT CONCRETE PIPE CO., *Respondent*.

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE NINTH CIRCUIT

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PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE NINTH CIRCUIT

Petitioners pray that a writ of certiorari issue to review the judgment of the United States Court of Appeals for the Ninth Circuit entered in the above entitled case on February 11, 1965.

CITATIONS TO OPINIONS BELOW

The opinion of the Court of Appeals is reported as *No-Joint Pipe Company* v. *R. A. Hanson et al,* 144 U.S.P.Q. 519 (9 Cir. 1965), which reverses an unreported decision of the United States District Court for the Eastern District

of Washington. Copies of the opinions of both courts below are printed in the Appendix.

JURISDICTION

The decision of the Court of Appeals was announced on February 11, 1965 and the Judgment thereon was entered the same day. Rehearing was denied on May 10, 1965.

The jurisdiction of this Court to review the judgment of the Court of Appeals herein by writ of certiorari is conferred by 28 U.S.C. 1254 (1).

QUESTIONS PRESENTED

1. Whether, after patent claims to a combination of mechanical features have been held valid and distinguished from prior patent disclosures, they can be construed by application of the doctrine of equivalents so as to expand the patent monopoly to cover a combination of features disclosed in an expired patent.

2. Whether a judgment of a trial judge based upon findings of fact of non-infringement of specific patent claims and a refusal to apply the doctrine of equivalents following resolution of conflicting evidence relating to pipe forming machines and related prior patents is properly reversed as a matter of law by a Court of Appeals.

CONSTITUTIONAL AND STATUTORY PROVISIONS

This case involves Article 1, Section 8, clause 8, of the Constitution and sections 111, 112 and 271 (a) of the

Patent Code of 1952, 35 U.S.C., § 111, 112 and 271 (a). These provisions are set forth in the Apendix, *infra*.

STATEMENT OF THE CASE

This is a civil action for patent infringement. Jurisdiction of the District Court is conferred by 28 U.S.C. 1338 (a).

Complaint (R. 1-8)* was filed on June 7, 1960 by No-Joint Concrete Pipe Co., a California corporation and assignee of the patent in suit, alleging infringement of United States Letters Patent No. 2,731,698 granted Jan. 24, 1956 entitled Apparatus for Forming Concrete Pipe in Situ. The accused devices were manufactured and used by petitioners to produce pipe in a trench following unsuccessful negotiations with respondents envisioning a mutual agreement for manufacture of machines by petitioners and a territorial franchise.

Claims 1 to 5 of the patent in suit (Ex. 1) define a particular apparatus for producing cast-in-place concrete pipe within a trench. The structure enumerated in the claims includes an inner form for the pipe including two distinct parts, the lower portion moving along the trench with the machine and the upper portion overlapping the lower portion and remaining stationary within the pipe until the concrete has set. A careful description of this apparatus

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*References to the appeal record are herein designated "R.", references to the trial transcript are designated as "Tr." and references to designated exhibits appended to the certiorari record are designated "Ex.".

was made by the trial judge in finding of fact 6 (R 42), capsuled by the Court of Appeals in its opinion (Appendix, *infra*, p. 8a).

The accused devices were manufactured and used without utilizing any moving innerform portion. They include a completely stationary full circle innerform, left in the pipe during setting of the concrete and removed after the pipe had become hardened.

Petitioners, in the conduct of their trial defense, relied upon statements made by respondent during prosecution of its patent application before the U. S. Patent Office (Ex. 2) as well as several prior patents to substantiate their claim that the accused devices did not infringe the scope properly accorded to claims 1 to 5 of the patent in suit. The prior patents show development of machines for this particular purpose dating back to 1884 (Ex. 41). In 1886, Patent No. 353,500 (Ex. 42) was granted to Ransome, showing a two step process for forming concrete pipe with overlapping lower and upper inner pipe forms. A patent on a further refinement of this machine was granted to Ransome in 1894, No. 517,808 (Ex. 43) illustrating the manner in which stationary segmented upper forms were fed in overlapping relationship relative to the moving lower form.

U. S. Patent No. 857,586 (Ex. 46) granted to Boyle was found by the trial judge to contain all of the elements defined in the language of the claims in suit with the exception of the specific inner form structure (Finding of Fact

11, R. 46). In the conclusion of the patent specification, it is stated that the patentee is "enabled to make monolithic reinforced conduits, *continuously* and of any length desired." (Emphasis added)

A later Ransome patent, No. 1,191,731 (Ex. 52) shows an apparatus for forming pipe in place using a full circle form that can be collapsed for removal from the hardened pipe.

Cast-in-place pipe, as opposed to pre-cast pipe, is principally used in this country in the southwest, particularly in the states of California and Arizona. A two step process of casting pipe in place, first forming the bottom of the pipe and then the top cover, has been used extensively in central California (Tr. 154). The No-Joint pipe was first used in irrigation applications and now is used primarily for municipal work in producing storm sewers (Tr. 155). Cast-in-place pipe has found application in large projects where it can meet the necessary structural requirements, due to its economy when compared to placement of pre-cast pipe (Tr. 34-35). Practically all cast-in-place pipe, whether made with No-Joint machines or by other methods, has been layed in California and Arizona (Tr. 123, 155), with only minor development in states located beyond the territorial limits of the Ninth Judicial Circuit. There is no present indication of widespread use of such methods in other geographical areas of the United States.

The trial before the United States District Court for the Eastern District of Washington at Spokane took two

and one half days. The principals of the respondent corporation testified concerning the development and progress of the No-Joint operation. An engineer and manager of a water distribution project for the state of Arizona testified as a licensee for respondent, explaining the production of pipe with No-Joint machines and offering his comparison of these machines with those made by the petitioners. Dual movies, showing parallel operation of both machines were exhibited and explained by this witness.

Raymond Hanson testified in his own behalf as to the development of his machines and their structural differences when compared to the No-Joint machines. His conclusions were substantiated by an independent professional engineer who had conducted tests for a purchasing city to determine the acceptability of pipe produced by petitioners (Tr. 293-295). No-Joint machines could not have been utilized in this instance, due to water standing in the ditch in which the pipe had been formed (Tr. 75, 76).

Petitioners also urged the defense of invalidity of the patents, relying upon prior art patents. These, and the file history of the patent in suit, were explained to the Court with the aid of an expert patent attorney.

The trial judge had before him the testimony of seven witnesses, each being personally knowledgeable in the area toward which his testimony was directed. Scaled models of the machines in question were introduced in evidence by both parties, as well as diagrammatic views and enlarged drawings showing both the present machines

and those developed in the prior art. The trial judge, after long consideration of the recorded trial transcript and written arguments of both parties was able to compare the prior art, the structure and mode of operations of the patented machine and the accused machines and the specific claims of the patent asserted to be infringed. His conclusion, stated first in a memorandum and order (Appendix, *infra*), was that the prior art required the limitation of the claims of the patent in suit. He found that since the claims of the patent were narrowed to secure it they could not now be enlarged by the doctrine of equivalents to ignore the plain language of the claims calling for an inner form with a lower movable member and an upper member disposed in overlapping slidable relationship with respect to the lower movable member. Since petitioners used only a one piece full circle form that remained stationary in the pipe, performing different functions from the patented device, the trial judge determined that petitioners had not substituted an equivalent structure in place of that claimed (R. 39, 40).

The judgment of the Court of Appeals (Appendix, *infra*) reversed the holding of the District Court, holding that the doctrine of file wrapper estoppel was not applicable and that the doctrine of equivalents applies to the facts of this case.

The opinion of the Court of Appeals reverses, by impliation, all Findings of Fact of the trial judge relating to the issue of infringement. It makes no mention of the prior art and the findings of the trial judge relating to them,

which relied upon a strict interpretation of the claims in support of claim validity.

With regard to novelty, the opinion of the Court of Appeals holds that "this method, in general, is not new in the art. What is new is the fact that the device permits a continuous operation." (Appendix, *infra* p. 8a) the court further states "the accused device adopts appellant's method, which, the record makes clear was a decided advance, enthusiastically embraced by the public." These conclusions of the Court of Appeals reflect a material error in the treatment of the patent claims, which are directed to a precise apparatus or machine. The history of the patent in suit (Ex. 2) makes clear that respondent eventually cancelled all claims to a method of producing pipe after repeated rejections by the Patent Office, leaving only the limited apparatus claims with which the court should have been properly concerned.

REASONS FOR GRANTING THE WRIT

Reason 1. No conflict of decision between Courts of Appeals involving the interpretation of the claims in issue is probable since the application of the machine involved has to date been primarily concentrated in states confined to the Ninth Judicial Circuit.

The application of cast-in-place pipe has developed primarily in California and Arizona. Large scale water projects in these states, both for irrigation and municipal purposes, have made desirable the utilization of more economical methods of laying pipe below ground level. The Southwest, with a rocketing population and soil conditions mak-

ing possible simple trenching methods, is particularly well adapted to the utilization of the machines in question. Despite minor application in other locations, it can be presumed that the major proportions of this pipe will continue to be specified and produced in these areas.

The significance of geographical concentration of a patented development have been several times stated by this Court in connection with writs of certiorari granted in patented cases.

In *Muncie Gear Works* v. *Outboard Marine & Mfg. Co.*, 315 U. S. 759 (1942), Mr. Justice Jackson, speaking for the majority, stated at pages 765-766:

> ". . . While there was no conflict of decision with respect to these claims, we granted certiorari in view of the questions presented and beause the patent dominates a substantial portion of an industry so concentrated in the Seventh Circuit that litigation in other circuits, resulting in a conflict of decisions, is unlikely."

The improbability of conflict of decisons was held to be no bar to the granting of certiorari in two other decisions of this Court prior to that written by Mr. Justice Jackson: *Exhibit Supply Co.* v. *Ace Patents Corp.*, 315 U. S. 126, 128 (1942), and *Schriber-Schroth* v. *Cleveland Trust Co.*, 305 U. S. 47, 50 (1938).

A conflict of decisions in this case is improbable because of a concentration of the utilization of cast-in-place pipe in the Ninth Circuit.

Reason 2. This case involves issues relative to the question of infringement similar to those presented in cases now set for argument before this Court, and it is in the public interest that the instant decision be reviewed so as to enable this Court to better define the limits of claim interpretation as the claims are applied to devices accused of infringing combination patent claims.

The contention of petitioners on the merits of this case is that the holding of infringement is contrary to the concurrent holding of validity in that the claims as now interpreted by the Court of Appeals will also read upon machines disclosed by an expired prior art patent now open for the public to use. (Ex. 46).

Similar questions are now before this Court in at least three patent cases set for hearing this term: *United States of America* v. *Bert N. Adams et al*, No. 55, *Calmar, Inc.*, v. *Cook Chemical Company*, No. 37 and *Colgate-Palmolive Company* v. *Cook Chemical Company* No. 43.

In the *Adams* case, the Court of Claims refused to expand certain claims to find infringement. Quoting from its opinion, *Adams* v. *United States*, 330 F. 2d 622 (Ct. Cl. 1964), at p. 627:

> "To allow the plaintiffs to expand the Adams patent claims to include other allegedly equivalent components, which were also in the known group of battery components at the time of the Adams invention, would be contrary to the finding of validity."

The related Cook Chemical Company cases involve a review by this Court of a finding by a trial court that the claims involved were infringed base upon the doctrine of

equivalence. The Court of Appeals affirmed, holding the question of equivalence to be factual. *Calmar, Inc.* v. *Cook Chemical Co.*, 336 F. 2d 110 (8 Cir. 1964).

It is submitted that a review of the instant case, together with those now set for argument, would greatly clarify the law applicable to claim validity and interpretation and therefore assist both courts and counsel when dealing with the issue of possible claim infringement. This case, involving questions of file history interpretation decided oppositely by the trial court and the appellate court, would complement the cases now on the calendar of this Court.

Reason 3. The effect of the decision of the Court of Appeals is to grant to respondent a monopoly on a result or method, contrary to the rules of claim interpretation established by this Court. It will seriously affect the public interest, since the primary application of cast-in-place pipe is in public projects by state, federal, and local agencies.

This Court has repeatedly held that "claims made in the patent are the sole measure of the grant" and that "the combination patent covers only the totality of the elements in the claim." *Aro Mfg. Co.* v. *Convertible Top Replacement Co.* 365 U. S. 336, 339, 344 (1961).

It has been conceded from the start of this suit that the language of the claims in issue cannot be expressly read upon the accused machines. Each claim calls for a two piece inner form: the lower portion of the inner form moving along the trench with the bulk of the machine, the

upper portion being in slidable overlapping relationship with the lower portion and remaining stationary until the pipe has set. The accused device uses a one piece, wholly stationary inner form.

The opinion of the Court of Appeals stresses the fact that the device permits a *continuous* operation, referring to the method of operation of the machine rather than to its structural components. The Court of Appeals has taken the position that the accused device adopts appellant's method, and has compared the method of operation of the machines and results obtained by the two machines. Nowhere in its opinion does the Court of Appeals make mention of the fact that at least two prior patents asserted by petitioners, (Ex. 41, 46) specifically mention that the machines described therein produce concrete pipe continuously.

The net effect of the opinion of the Court of Appeals in the instant case is to place anyone continuously casting pipe in place in peril of being held to infringe these limited, precisely worded patent claims. This is true despite the finding of fact by the trial judge, in holding the claims valid, that all of the essential elements in the claims, with the sole exception of the specific inner form structure, were clearly disclosed in combination in a single prior patent (Finding of Fact 11, R. 46, 47).

The No-Joint machines originally were used in the irrigation field and now are used mostly in municipal work for producing storm sewers (Tr. 155). Such projects are pri-

marily developed, financed and supervised by public agencies. If the decision of the Court of Appeals in this case is not overturned, it would seem improbable that any company could compete effectively with the respondent in competitive bidding to meet the specifications required of cast-in-place pipe as layed down by such agencies. The resulting lack of competition in public bidding and monopolization of an entire industry by broad interpretation of patent claims seem obviously to be in conflict with the purpose of the constitutional provisions relating to patents and the clear intent of our patent laws to grant only limited monopolies in given industrial areas. The opinion of the Court of Appeals is in direct conflict with this Court's ruling that once a patent issues, it is strictly construed, and cannot be used to secure any monopoly beyond that contained in the patent. *Sears, Roebuck & Co.* v. *Stiffel Co.*, 376 U. S. 225 (1964).

Reason 4. The direction by the Court of Appeals of a judgement finding petitioners to infringe the patent in suit requires judicial rewriting of claims, contrary to the standards of claim interpretation set out by this Court and without recognition of the trial judge's findings that such broadening of the claims would render the claims invalid.

In finding of fact 29 (R. 51, 52) the trial judge found that a review of the file wrapper of this patent indicates that the prior art required limitation of the claims in issue and that they must therefore be given a narrow construction. After carefully analyzing the existing prior patents, the trial judge found that the claims must be limited to the particular inner form structure set out in the claim lan-

guage, since the inner form configuration constitutes the only structural element of the claims not clearly disclosed in combination by the prior patents.

The Court of Appeals, in its opinion, ignores the clear language of the claims in suit and eliminates entirely all restrictions defined in those claims relating to the specific inner form structure utilized in the patented device. In place of the clear definition of the major cooperating parts of the patented device, the Court of Appeals has erroneously substituted its own interpretation of what the respondent should have claimed during prosecution of its application before the Patent Office.

Respondent carefully drafted its application and claims in accord with usual practice required by 35 U. S. C., § 111, 112, and submitted four complete amendments to the claims during prosecution of the application in the Patent Office. Both method and apparatus claims were originally presented and rejected. The apparatus claims were progressively limited, particularly with respect to the inner form structure so important to the outcome of this suit. A study of the file history (Ex. 2) shows clearly that the claims were consciously restricted to a definite apparatus including a two piece inner form. The prior art shows that such restriction was necessary in order to establish patentable novelty, as concluded by the trial judge.

The findings of fact made by the trial judge to this effect were supported by substantial evidence and were erroneously reversed by the Court of Appeals. The conclusion of

the Court of Appeals, based primarily upon similarity of results, seems in conflict with the established rules of this Court. In the decision of *Wright* v. *Yuengling*, 155 U. S. 47 (1894), a similar situation was presented and a holding of infringement rejected:

> "Now, while this semi-circular connecting piece may be an immaterial feature of the Wright invention, and the purpose for which it is employed accomplished, though less perfectly, by the extension of the guiding cylinder in the manner indicated in defendant's device, yet the patentee, having described it in the specification and declared it to be an essential feature of his invention, and having made it an element of these two claims, is not now at liberty to say it is immaterial, or that a device that dispenses with it is an infringement, though it accomplishes the same purpose in, perhaps, an equally effective manner." 155 U. S. 52.

This Court has repeatedly refused to permit broadening of patent claims where the applicant, in order to meet objections in the Patent Office based on references to prior art, adopted a restrictive phrase as a substitute for one broader. Amendment of claims, recognizing and emphasizing differences between such phrases has been held to proclaim abandonment of all that is embraced in the difference. *Exhibit Supply Co.* v. *Ace Patents Corp.*, 315 U. S. 126 (1942). This Court has held that one who avoids prior art by defining his invention specifically cannot disregard that precision to establish infringement. *Makay Radio & Telegraph Co.* v. *Radio Corporation of America*, 306 U. S. 86 (1938).

Reason 5. The instant opinion and other recent opinions of the Ninth Circuit Court of Appeals relating to the application of the Doctrine of Equivalents show a disregard of the clear interpretation of claims asserted by patentees before the Patent Office during prosecution of the patents in issue, thereby rendering impossible the forecasting of patent claim interpretation by advising counsel prior to litigation, seriously handicapping those desiring to compete with a patented device.

The Constitutional purpose of our patent system is to promote the progress of useful arts. This can only result if the monopolies granted under our patent laws are effectively limited to their proper spheres. Congress has placed in the Patent Office the responsibility of primarily determining the novelty of inventions and providing, for public use, printed specifications and claims setting out the boundaries of these limited monopolies. Counsel seeking to advise a manufacturer concerning possible infringement has recourse to three basic sources of information: The patent, its file history before the Patent Office, and the prior art.

The instant patent (Ex. 1) contains only claims which specifically recite a two piece inner form structure with one piece moving with respect to the other. No claim in the patent expressly covers a one piece stationary innerform.

The file history of this patent (Ex. 2) shows repeated arguments pointing out to the Patent Office that the apparatus claims differ from the prior art in that they include two piece innerforms with the lower section moving along the trench while pipe is placed about it.

The prior art patents (Ex. 41-43, 46, 52) show that all of the elements involved are old in themselves, and that all of the claimed elements, with the sole exception of the specific innerform structure, are clearly illustrated in one patent (Ex. 46) in the same combination as defined in the claims in suit.

The conclusion to be drawn from these facts is that the accused machines, using only a full circle innerform and completely eliminating any moving innerform section, do not infringe the claims as prosecuted before the Patent Office. It was on this assumption, and upon advice of counsel, that petitioners commenced production of the accused machines following the termination of unsuccessful negotiations with respondent machines (Tr. 214-216).

In its opinion (Appendix, *infra.*) the Court of Appeals, in footnote 6, sets out a clear argument made by respondent to the Patent Office emphasizing language employed in claims 9 and 10 as then presented, stating that these claims require means for simultaneously moving the lower section of the innerform with the machine and that such means are not suggested by the prior art. In spite of this clear interpretation of its own claims as asserted by respondent, the Court of Appeals has chosen to ignore this definition in order to find infringement by the accused device.

Two other decisions of the Court of Appeals for the Ninth Circuit evidence a recent tendency to disregard clear written claim language and accompanying argument pre-

sented during the prosecution of a patent application before the Patent Office. Both were relied upon by the Court in support of its opinion in this case.

In the decision of *International Mfg Co.* v. *Landon Inc.* 336 F. 2d 723 (9 Cir. 1964) the Court of Appeals found infringement by application of the doctrine of equivalents. The remarks made by the applicant during prosecution of the claims in issue specifically emphasized the fact that the claims were addressed to a specific filter structure, and were presented with the prior art in view. The particular claimed filter structure was not used in the accused device, but the Court of Appeals chose to ignore this claim limitation and found infringement.

In *M. O. S. Corporation* v. *John I. Haas Co.*, 332 F. 2d 910 (9 Cir. 1964) the Court of Appeals disregarded an affidavit by the inventor in a reissue application specifying that the claims in suit were limited to a method of packing hops utilizing two drums. The reissue application was denied, and suit was brought on the original claims. The Court of Appeals found infringement by enlargement of the claims by the doctrine of equivalents where the defendant used only one drum, again totally disregarding the clear statements of the inventor himself with regard to the scope of the patent claims.

This Court has heretofore held that arguments made by the patentee in distinguishing his invention from prior art must be recognized and considered by Courts in interpreting claims. *Schriber-Schroth Co.* v. *Cleveland Trust Co.*, 311 U. S. 211, 220 (1940).

The effect of the present decision of the Court of Appeals for the Ninth Circuit, and the other recent decisions set out above, is to make impossible the competent evaluation of patent claims that might become the subject of litigation in this judicial circuit. The resulting uncertainty can only adversely affect our valuable system of free competition and requires more stringent guidelines pertaining to claim interpretation to aid both courts and counsel.

Reason 6. In the present instance, the Court of Appeals has proceeded erroneously to overturn clearly supported Findings of Fact made by the trial judge after two and one half days of testimony and carefully briefed arguments, contrary to the clear directions of this Court.

In *Graver Tank & Mfg. Co. v. Linde Air Products Co.*, 339 U. S. 605 (1950) at page 605, this Court held:

> "What constitutes equivalency must be determined against the context of the patent, the prior art, and the particular circumstances of the case."

The Court of Appeals, in its opinion, makes no specific mention of prior art patents relating to the claims in issue here. It disregards the fact findings of the trial court which emphasize the close similarity of many prior patents with the claimed device. The trial court has been reversed on an issue of fact without reference to the all-important consideration of the prior art, which must necessarily set the boundaries of any patented apparatus. This is an erroneous legal judgment, contrary to proper rules of appellate procedure.

The Court of Appeals for the Ninth Circuit has ignored the admonition in the *Graver Tank* case:

> "A finding of equivalents is a determination of fact. Proof can be made in any form: through testimony of experts or others versed in the technology; by documents, including texts and treatises and, of course, by the disclosures of the prior art. Like any other issue of fact, final determination requires a balancing of credibility, persuasiveness and weight of evidence. It it to be decided by the trial court and the court's decision, under general principles of appellant review should not be disturbed unless clearly erroneous." 339 U. S. 605, 609.

The trial court findings on the issue of alleged infringement are adequately supported by the record. Certainly they are not clearly erroneous. The Court of Appeals did not find error in the law applied by the trial court, holding that the sole issue upon appeal is the contention that the petitioner's one piece inner core is the mechanical equivalent of respondent's two piece core. The District Court found as a fact that it was not and the Court of Appeals stated "in this we feel that the District Court has erred". Clearly this constitutes a reversal of a finding of fact.

CONCLUSION

For the foregoing reasons, this petition for write of certiorari should be granted.

Respectfully Submitted,
CHARLES F. SCANLAN
Counsel for Petitioners

Date: July 6, 1965

APPENDIX

CONSTITUTIONAL AND STATUTORY PROVISIONS

Constitution of the United States:

Art. 1, Sec. 8. "The Congress shall have power . . . To promote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries."

United States Code, Title 35 — Patents:

"111. Application for patent

Application for patent shall be made by the inventor, except as otherwise provided in this title, in writing to the Commissioner. Such application shall include: (1) a specification as prescribed by section 112 of this title; (2) a drawing as prescribed by section 113 of this title; and (3) an oath by the applicant as prescribed by section 115 of this title. The application must be signed by the applicant and accompanied by the fee required by law.

"112. Specification

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

"The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

"An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

"271. Infringement of patent

(a) Except as otherwise provided in this title, whoever without authority makes, uses or sells any patented invention, within the United States during the term of the patent therefor, infringes the patent."

In The United States District Court
Eastern District of Washington
Northern Division

NO-JOINT CONCRETE PIPE CO., a corporation,
Plaintiff,

vs.

R. A. HANSON, an individual, and R. A. HANSON CO., INC., a corporation.
Defendants.

No. 1958

Memorandum and Order

This suit for patent infringement was tried by the court without a jury and was submitted on written briefs. Oscar A. Mellin and Jack E. Hursh, of Mellin, Hanscom & Hursh, appeared for plaintiff. John D. MacGillivray, of MacGillivray, Jones, Clark & Schiffner, Greek Wells, Richard J. St. John and Neil & Aitken appeared for defendants.

The patent in suit is No. 2,731,698 which was issued to Elmer Le Roy Tunsen on January 24, 1956, and plaintiff's title by assignment is admitted by the pleadings.

The patented machine fits within a preformed trench and is moved along in a continuous manner with concrete being poured into the machine and concrete pipe being formed directly in place which is used for irrigation, drainage and other low pressure purposes.

The patent in suit had long been needed by the industry and was immediately a commercial success. It produced concrete pipe for about half the cost of precast pipe which was being used by the industry and which had joints requiring sealing.

The patent in suit is valid, although it is a combination of old elements, because it has a new modus operandi which produces an improved result in a more economical way.

The issue of infringement depends upon the construction or interpretation to be given to claims 1 to 5 of the patent in suit. These claims, with broad construction, would read on any device which continuously formed concrete pipe in place, including defendants' accused device.

However, a review of the file wrapper indicates that the prior art required the limitation of the claims of the patent in suit. The claims of the patent in suit, therefore, must be given a narrow construction. With a narrow construction, defendants' accused device does not infringe claims 1 to 5 of the patent in suit, as these claims all require "an inner form comprising a lower movable member secured to the barrier" and "an upper member . . . . disposed in overlapping slidable relationship with respect to the lower movable member."

Defendants' accused device uses a one-piece full circle form that remains stationary in the pipe until the concrete is set.

Plaintiff contends that since the accused device accomplishes substantially the same result by substantially the same means as the patent in suit, the doctrine of equivalents applies. However, since the claims of the patent in suit were narrowed to secure the patent, they cannot now be enlarged by the doctrine of equivalents to make the accused device infringe said claims.

Plaintiff also contends that defendant does not avoid infringement by substituting a one-piece circular inner form for a two-piece inner form used by the patent in suit. However, defendant's one-piece inner form performs different functions from the patented device in addition to physically changing the machine to handle the full circle form, and it is not movable or attached to the barrier as is the lower inner form of the patent in suit.

Defendants' accused device is made up of elements all of which are in the public domain, and these elements are in different combination than the patent in suit. Defendants' accused device has eliminated the moving inner form of the patent in suit and has not substituted an equivalent structure so does not infringe the patent in suit.

Plaintiff has asked for attorneys' fees, and if plaintiff had prevailed, I would have granted them. This is the exceptional case where defendant, having no prior experience in the concrete pipe business, negotiated with plaintiff for a franchise to manufacture and distribute the patented device. When negotiations failed, defendant set out to find a substitute device by combining old elements in the pub-

lic domain from prior art patents received from the patent office.

Defendant's request for attorneys' fees is denied.

Judgment and costs for defendant.

Counsel for defendant is directed to prepare findings of fact, conclusions of law and judgment in accordance with Rules 13 and 14 of the Civil Rules for the Eastern District of Washington.

Dated: May 22nd, 1963.

M. D. CROCKER

United States District Judge

United States Court of Appeals
For the Ninth Circuit

NO-JOINT CONCRETE PIPE CO., a corporation,
Appellant,

vs.

R. A. HANSON, an individual, and R. A. HANSON CO., INC., a corporation.
Appellees.

No. 19,403

[February 11, 1965]

An Appeal from the United States District Court for the Eastern District of Washington, Northern Division

Before: MERRILL, DUNIWAY and ELY, Circuit Judges

MERRILL, Circuit Judge:

Appellant has brought this suit for infringement of patent.[1] Appellees defended upon the grounds, first, that appellant's patent was invalid for lack of invention, and,

[1]Tunsen patent No. 2,731,698 issued January 24, 1956. Claim 1, which represents the claims in issue, reads:

"An apparatus for producing cementitious conduits in a trench or ditch,

1. comprising an upright movable barrier having a configuration substantially conforming to the cross sectional configuration of

second, that there was no infringement. The District Court for the Eastern District of Washington, Northern Division, held the patent to be valid but not infringed. Appellees challenge the first holding. Appellant appeals from the second.

The device in question is for the forming of concrete pipe in place for use in irrigation and drainage systems. By means of the device pipe is formed by the following method: A ditch is dug, conforming to the outer dimensions of the pipe. Concrete is fed into the ditch around an inner core or form which is removed after the concrete has set. This method, in general, is not new in the art. What is new is the fact that the device permits a continuous operation. New pipe is continuously poured while the already formed pipe is still hardening. Thus it is not necessary to permit one section of the pipe to harden before passing on to

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the ditch in which the conduit is to be formed and adapted to be moved along the ditch with its plane arranged normal to the longitudinal axis of the ditch,

2. an inner form comprising a lower movable member secured to the barrier inwardly of the bottom and sides thereof and extending rearwardly from the barrier and defining a space with the bottom of said ditch,

2a. said form including an upper member composed of a plurality of sections realeasably secured together, disposed in overlapping slidable relationship with respect to the lower movable member and extending through the barrier in slidable sealing engagement therewith,

3. an outer form member secured to the barrier and defining a space with respect to said upper member,

3a. said outer form member having an opening therein communicating with the space between the inner form and the outer form member and between the inner form and the bottom of the ditch for the introduction of settable material,

4. and means for moving said barrier longitudinally of the ditch and with respect to said upper member."

the pouring of a new section. Also, the top, bottom and sides of the pipe are formed simultaneously. This is accomplished by pouring concrete through a hopper around a conduit through which overlapping sections of the inner core are continuously fed, with the entire device resting on the bed of the ditch and steadily advancing along the ditch by means of a powered winch.

The District Court has found that although it is a combination of old elements, this patent is valid, "because it has a new modus operandi which produces an improved result in a more facile, economic and efficient way." This finding is not clearly erroneous. We conclude that the District Court was not in error in ruling appellant's patent to be valid, and direct our attention to the question of infringement.

The accused device adopts appellant's method, which, the record makes clear, was a decided advance, enthusiastically embraced by the public.

There is, however, one difference in the details of the competing devices around which the issues here revolve. This relates to the inner form or core, which is fed through the conduit. In the patented device the core is in two pieces. The upper portion is fed through the conduit in overlapping sections and remains stationary, supporting the upper portion of the pipe until the concrete has hardened. It stays behind (as the device moves forward along the ditch) and is removed later. The lower portion of the inner core is attached to the device and moves with it, leaving exposed the lower portion of the pipe.

In the method adopted by the accused device a one-piece full-circle inner core is fed through the conduit in overlapping sections and in its entirety remains behind, stationary in the pipe, until the concrete has set.

Upon the appeal the sole question is presented by appellant's contention that appellees' one-piece inner core is the mechanical equivalent of appellant's two-piece core. The District Court has ruled that it was not.

In this we feel that the District Court has erred. Both cores accomplish precisely the same function of providing the inner form for the pipe. Both, in the words of appellant's Claim 1, are composed of "a plurality of sections releasably secured together * * * and extending through the barrier [i.e., fed through what we have termed the "conduit"] in slidable, sealing engagement therewith." Thus both permit of a continuous operation by virtue of their composition and the manner in which they are introduced into the ditch. A substantial body of law recognizes that infringement is not avoided by making into one part that which has been shown as two.[2]

Appellees contend that the cores accomplish an important secondary purpose, and do so in different ways,

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[2] *Industrial Instrument Corp. v. Foxboro Co.*, 307 F.2d 783, 786 (5 Cir. 1962), *modified*, 310 F.2d 686 (1962); *Zysset v. Popeil Bros. Inc.*, 276 F.2d 354, 357-358 (7 Cir. 1960), cert. denied, 364 U.S. 826 (1960); *Specialty Equip & Madi. Corp. v. Zell Motor Car Co.*, 193 F.2d 515, 518 (4 Cir. 1952); *Royal Typewriter Co. v. Remington Rand, Inc.*, 168 F.2d 691, 693 (2 Cir. 1948) (L. Hand, J.); cert. denied, 335 U.S. 825 (1948); *Apex Mfg. Co. v. Maytag Co.*, 122 F.2d 182, 187 (7 Cir. 1941), cert. denied, 314 U.S. 687 (1941).

and that this prevents the doctrine of equivalents from applying. Appellees refer to the manner in which the bottom of the pipe is formed. The problem here is that of assuring that the concrete has fully reached and compacted below the inner core. The patented device accomplishes this by a removable vibrator and tampers. Also, however, it is apparent that the movable lower inner core does, in its motion over the concrete, accomplish a compacting, spreading and trowelling of the bottom of the pipe against the underlying ditch. This trowelling action is absent in the accused device, which operates by means of mechanically activated "consolidating rings" upon which appellees have secured a patent. Appellees also point out that each form of inner core has its advantages over the other.

But it is not the form of the inner core (whether one or two pieces — whether wholly stationary until setting has occurred or only partially stationary) which accomplishes any different result. The function of the core is simply to serve as a form around which the concrete is compacted or consolidated. That which accomplishes a different result is the means chosen in collaboration with the inner core for compacting or consolidating the concrete forming the bottom of the pipe. That appellees may have found and patented an improved method of compacting concrete around the core does not preclude their one-piece core from being the mechanical equivalent of appellant's two-piece core.

Nor does the fact that each core has its advantages over the other per se prevent application of the doctrine of equivalents in every case. Whenever equivalents present themselves a choice is presented and every choice presumably is governed by the chooser's view as to what is preferable or advantageous. Here the respective advantages were not of such dimensions as to amount to the accomplishment of different results.[3]

Appellees' contentions would have the effect of limiting the scope of appellant's invention to the manner chosen for compacting the concrete. The claimed combination encompasses a far greater area of novelty and invention than that.

Appellees contend that file-wrapper estoppel precludes appellant from asserting the doctrine of equivalents as to the form of inner core and limits appellant's claim to the precise inner core specified. The District Court so held. In this respect, too, we feel that the District Court was in error.

The application for the Tunsen (appellant's patent originally included broad method claims[4] and apparatus claims[5] which were rejected by the Patent Office as being so

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[3]The two-piece core had the advantages of trowelling the bottom portion of pipe and of leaving it briefly exposed to view so that the condition of its formation was continuously unfolded as the device moved forward along the ditch. The one-piece core provided continuing inner support and cover for the bottom of the pipe until it had set, which was of advantage in case the ditch was wet or exposed to water.

[4]Original Claim 1 read:

"The method of producing a conduit, which comprises forming a ditch with a bottom conforming to the shape of the finished conduit, placing an inner form in said ditch spaced from said bottom, depositing

broad as to encompass prior art. Specifically, the examiner at this point was concerned with a prior Ransome patent which disclosed a method of in-place pouring of concrete pipe. The Ransome method was not continuous. The bottom was poured first and then the top, or cap. One section had to set before the apparatus could be moved on to a new section. Tunsen's original claims were stated so broadly as to encompass this intermittent method.

Certain of these claims were then withdrawn by Tunsen. One of the original claims was amended to specify *simultaneous* motion of the upper outer form and lower inner form. It is the remarks of Tunsen in support of this amendment upon which appellees principally rely in their contentions of estoppel.[6]

The examiner was not persuaded. In the next action which he took *all* claims were rejected for lack of inven-

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cementitious material around said inner form and upon said bottom, and removing said inner form after said cementitious material has become form sustaining."

[5]Original Claim 8 read:

"In apparatus for producing cementitious conduits in a ditch provided in the ground: an inner form; means for holding said form in spaced relation to the walls of the ditch; and means for moving at least a portion of said form longitudinally of the ditch which cementitious material is being deposited around said form."

[6]"Claim 5 has been amended to call for an operational step wherein there is a simultaneous moving of the lower section and outer form. Clearly such an operation is not possible with the Ransome disclosure. In order for such an operation to take place, the core must also be moving, yet Ransome clearly requires the core to remain stationary while the invert and cap sufficiently harden to be form-sustaining. Further, it should be noted that Ransome requires that the core be collapsed before moving it forward, thereby allowing free movement of the core out of the hardened conduit. Claims 9 and 10 have been amended to include means for simultaneously moving said outer form and lower section of the inner form. Such means are not suggested by Ransome."

tion over other Ransome patents. Tunsen started all over again, confining his claims to apparatus claims. One statement made by Tunsen in his remarks in support of these claims is singled out by appellees: "All of the claims bring out the idea of a barrier moving along a ditch and carrying an outer form and part of the inner form, the other part of the inner form being temporarily left in place in the formed conduit. The stationary parts of the inner form slidably extend through the barrier and over the movable parts of the inner form carried by the barrier."

In specific relation to Ransome, however, the remarks state:

> "Ransome • • • [shows] an apparatus for first forming the bottom of the conduit, and then subsequently forming the sides and then subsequently forming the top. It is true that Ransome—517,808 does show the idea of temporarily leaving part of the inner form in the conduit, but that is the extent of the similarity to applicant's invention. Ransome—517,808 cannot form the top, bottom and sides of a conduit simultaneously, but must form them in sequence and as a result of this the apparatus is complicated and expensive. Applicant's construction is first much simpler and less expensive than Ransome's, and besides it permits the simultaneous formation of the top, bottom and sides of the conduit to obtain a sounder conduit in that, for instance, dirt cannot fall on exposed partially formed side walls as is the case in Ransome.

Clearly, the provision for a movable lower inner form was not included for the purpose of escaping Ransome, nor relied upon at this point as differentiation. Indeed, Tunsen felt called upon to justify the fact that Ransome also left

"part of the inner form" in the pipe. What Tunsen did rely upon was the fact that Ransome did not permit the simultaneous pouring of a complete pipe.

The examiner still was not persuaded. All claims again were rejected "as unpatentable over Ransome * * * in view of Boyle and Carr." Further, the examiner stated, "Applicant states that Ransome cannot form the top, bottom and sides of the conduit simultaneously, but he fails to state why and he fails to point out any statement in the Ransome patent indicating that the parts of the conduit must be formed in sequence."

In response to this action Tunsen adhered to his claims (subject to certain minor amendments to meet the examiner's further charge of indefiniteness and "informality"). In his remarks[7] he emphasized and reiterated that the ad-

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[7]"Claims 22 to 26 and 29 to 31 were rejected as being unpatentable over Ransome 517,808 in view of Boyle and Carr. Inasmuch as none of these patents provides apparatus capable of producing a complete pipe in a continuous fashion, it is believed that their combination would likewise fail to provide such an apparatus. In the case of the Ransome patent, there is insufficient disclosure regarding the form structure to ascertain just how the apparatus operates. This particular patent is devoted to the formation of a helical reinforcing material. By reference to an earlier patent to the same inventor, 353,500, the manner of molding the pipe itself becomes clear. In this earlier patent it appears that the concrete is laid up by hand or otherwise formed on the sides of the ditch to a shape approximating that of the mold and to a length equal to or shorter than the mold. There is no disclosure of the underlying thought in these Ransome patents of continuously forming a complete pipe nor of apparatus capable of doing so. Similarly, there are two pieces of apparatus in the Carr patent sequentially employed to form the lower portion of the pipe and then the upper portion. There is no apparatus in this patent that would possibly produce a complete pipe continuously. Similarly, in Boyle the operation is necessarily intermittent since there is no way to move

vance over Ransome, Boyle and Carr was in "continuously forming a complete pipe" and pointed out how the cited prior art failed to accomplish this result.

The claims in issue were then allowed.

From these facts it is apparent that the narrowing and re-definition of his claims by Tunsen in order to escape cited prior art did not relate to a movable lower inner form. This movable portion had been claimed from the outset. (See original Claim 8, footnote 5, *supra.*) The redefinition was for the purpose of limiting the claimed apparatus to one which would continuously form a complete pipe. In our judgment the doctrine of file-wrapper estoppel is not applicable upon these facts. *International Mfg. Co. v. Landon*, 336 F.2d 723, 727 (9 Cir. 1964); cf., *M.O.S. Corp. v. Haas Co. Inc.*, 332 F.2d 910 (9 Cir. 1964).

We conclude that the doctrine of equivalents applies to the facts of this case and that appellees' device is in infringement of appellant's valid patent.

Judgment reversed.

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an outer mold relative to an inner mold nor to add sections to an inner mold as is contemplated in the present application.

It is quite probable that by removing the informalities to which the Examiner in the last Official Action, the grounds of rejection predicated upon these patents will have been overcome.

Upon careful consideration of the claims as now presented, it is believed that the Examiner will be justified in passing the application for issue. Such action is requested at an early date."

United States Court of Appeals
For the Ninth Circuit

NO-JOINT CONCRETE PIPE CO., a corporation,
Appellant,

vs.

R. A. HANSON, an individual, and R. A. HANSON CO., INC., a corporation.
Appellees.

No. 19,403
(Civ. 1958)

APPEAL from the United States District Court for the Eastern District of Washington, Northern Division.

THIS CAUSE came on to be heard on the Transcript of the Record from the United States District Court for the Eastern District of Washington, Northern Division, and was duly submitted.

ON CONSIDERATION WHEREOF, It is now here ordered and adjudged by this Court, that the judgment of the said District Court in this Cause be, and hereby is reversed with costs in favor of the appellant and against the appellees, and that this cause be and hereby is remanded to the said District Court for further proceedings.

It is further ordered and adjudged by this Court that the appellant recover against the appellees for its costs herein expended and have execution therefor.

Filed and entered February 11, 1965